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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,171	01/21/2000	Frank A. Doljack	DOLJP103WOUSA	5489

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12/14/2004

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EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/489,171

Applicant(s)

DOLJACK, FRANK A.

Examiner

Paul Callahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-111 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 44-67, 77-107, drawn to a method for verifying the authenticity of goods, comprising the steps of generating one of more combination codes, where each combination code has a random portion and a non-random portion, encrypting the combination code, associating the combination code with one or more goods, wherein each of the goods has a unique encrypted combination code, and examining the goods and thereby verifying whether they are authentic by decrypting the encrypted combination code and verifying the decrypted code, classified in class 705, subclass 62.
 - II. Claims 68 and 69, drawn to a method for detecting a diversion of goods from a distribution channel, where each distribution channel has a unique encryption key to encrypt a combination code and means to verify whether an encryption key used to encrypt a combination code associated with an item found in a distribution channel matches the encryption key that is uniquely associated with that channel, classified in class 705, subclass 28.

- III. Claims 70-76, and 108-111, drawn to a method for determining if a tax has been properly paid to an entity comprising; creating a plurality of encryption codes, supplying these codes to an entity for application to goods, decrypting the codes via use of a public key, and determining if the tax has been properly paid by verifying that decrypted combination code is one of the plurality of codes provided, classified on class 705, subclass 31.

2. The inventions are distinct, each from the other because:

Inventions I, II, and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are:

Claim group II, directed towards verification that a tax associated with an applied, encrypted combination code has been paid. Only indicia that have been encrypted with a properly supplied key are indicative of the tax having been paid. The claims in group II additionally specify that the encrypted combination code or indicia is decrypted with a public key. Therefore claim group II contains features not useable with claim group I, and have a different outcome, since the verification of the decrypted combination code in claim group II is done by verifying that a proper key was used, in contrast to claim

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group I where comparison of a decrypted combination code with a stored version is used to verify that a product is authentic. Claim group II specifies use of a public key in decrypting the encrypted combination code, in contrast to claim group I and III that do not. Therefore the method of claim group is not useable with claim groups I or II.

Claim group III, directed towards a system for determining if a good has been diverted from a distribution channel. Each of a plurality of different distribution channels for a product has a unique encryption key associated with it used to encrypt a combination code. This is in contrast to claim groups I and II where a plurality of keys are supplied to a single entity or distribution channel. Therefore the system of claim group III is unusable in the methods of claim groups I and II. Verification that a good has not been diverted is accomplished by decrypting the encrypted combination code and determining that the code was encrypted with a key unique to that distribution channel. Therefore the process of verification in claim group III differs and is unusable with groups I and II.

3. Because these inventions are distinct for the reasons given above and the search required for Groups II and II is not required for Group I, restriction for examination purposes as indicated is proper. Claim group II requires searching in at least additional classes/subclasses 705/28,29; 283/55 not required for claim groups I and II; claim group III requires searching in at least additional classes/subclasses 705/30,31; 283/71, 32.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

12/01/04

Paul Callahan

Andrew Caldwell
Andrew Caldwell